

REMARKS

Claims 1-6 and 8-22 are pending in this application. Claims 11-18 are allowed. By this Amendment, claims 1-3, 5, 9 and 20-22 are amended. No new matter is added.

I. Personal Interview

The courtesies extended to Applicant's representative by Examiner Nerbun at the interview held June 15, 2004, are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below and constitute Applicant's record of the interview.

II. Allowed Claims

Applicant appreciates the allowance of claims 11-18. Applicant submits that pending claims 1-6, 8-10 and 19-22 are allowable for the reasons discussed below.

III. Claim Rejections Under 35 U.S.C. §102

Claims 1-6, 8-10 and 19-22 are rejected under 35 U.S.C. §102(b) as anticipated by each of U.S. Patent 4,292,907 to Gilbride et al. (hereinafter "Gilbride") and U.S. Patent 4,230,055 to Kaempfer. The rejection is respectfully traversed.

As discussed during the personal interview, neither Gilbride nor Kaempfer disclose each and every feature recited in the rejected claims, as amended. For example, neither of the applied references discloses a sewing apparatus where sewing is performed by causing a thread to remain in a workpiece, comprising *inter alia* . . . a hollow needle that moves up and down to pass the thread into the workpiece . . . a holding member that presses at least a part of the thread connecting two consecutive stitch points to the workpiece in accordance with a relative movement between the needle and the workpiece, wherein the holding member retains a part of the thread between one stitch point and a succeeding stitch point to prevent unraveling.

Regarding the rejection under Gilbride, the Office Action alleges that the presser foot 10 corresponds to the holding member recited in the rejected claims because the cylindrical shape of the presser foot 10 enables the presser foot to hold a part of the thread between one stitch point and a succeeding stitch point, since the thread exiting from the needle between one stitch point and another must intersect the circle formed by the base of the cylindrically shaped presser foot.

Applicant submits that Gilbride discloses "a functional element commonly found in nearly all sewing machines, namely, a presser foot" (col. 1, lines 6-8). The commonly found presser foot of Gilbride is described as performing "the function of preventing the material that is being sewn from lifting when the needle is being withdrawn from the workpiece. This tendency of the workpiece to lift with the needle will otherwise cause flagging and hence improper stitching" (col. 1, lines 15-19). It is an object of Gilbride to provide an improved presser foot apparatus which allows multi-level work to be successfully stitched at high speeds (col. 1, lines 62-64).

Thus, the presser foot of Gilbride is not described as pressing at least a part of the thread connecting two consecutive stitch points to the workpiece or retaining a part of the thread between one stitch point and a succeeding stitch point to prevent unraveling. In other words, Gilbride merely provides a commonly found presser foot that is height adjustable to allow use with multiple layers of material.

Although the Office Action indicates that a presser foot must hold a part of the thread between successive stitches due to its shape, such is not disclosed in Gilbride. Additionally, merely because the presser foot (or holding member) contacts a stitch portion, does not necessarily result in such a contact retaining a part of the thread between successive stitches to prevent unraveling. Furthermore, Gilbride is silent regarding how the stitches are retained

in place. Thus, Gilbride does not disclose that stitches are retained in place by the presser foot.

Additionally, as the rejected claims are amended to recite a "hollow needle", as suggested by the Examiner, Applicant submits that the revised claims distinguish over the applied references.

Regarding the rejection of the claims under Kaempfer, the Office Action alleges that Kaempfer discloses a holding member 62 (cylindrical hollow nose of the bearing sleeve 50) that corresponds to the holding member recited in the rejected claims.

Like Gilbride, Kaempfer also discloses a material hold down mechanism (col. 1, lines 5 and 6), and is directed to holding down multiple layers of material during stitching (col. 1, lines 32-43). However, Kaempfer is silent regarding a hollow needle or a holding member that presses at least a part of the thread connecting two consecutive stitch points to the workpiece ... wherein the holding member retains a part of the thread between one stitch point and a succeeding stitch point to prevent unraveling.

Rather, Kaempfer discloses the use of a solid needle and the use of a conventional lower bobbin. Such a bobbin would provide a lower thread which would interlock with the stitching thread to prevent the thread from unraveling (col. 2, lines 53-57).

The Office Action further alleges that the recitation of the part of the thread being held being less than the entire amount of the thread between stitch points does not impart patentability to the claims because it is merely inclusion of material or an article worked upon by the claim structure.

Applicant submits that the amended claim language, for example of claim 1, reciting "wherein the holding member retains a part of the thread between one stitch point and a succeeding stitch point to prevent unraveling" is not the inclusion of material or article worked upon by a structure being claimed, but rather describes a functional limitation of the

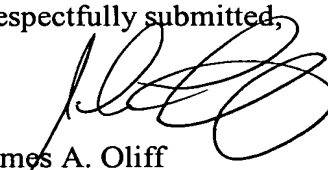
structure. A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of original skill in the potential art and the context in which it is used (MPEP §2173.05(g)). Accordingly, Kaempfer does not disclose a holding member that retains a part of the thread between one stitch point and a succeeding stitch point to prevent unraveling. Accordingly, Applicant respectfully requests the rejection of claims 1-6, 8-10 and 19-22 under 35 U.S.C. §102(b) be withdrawn.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1-6 and 8-22 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,


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